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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/040,771 | 01/09/2002 | Christoph Raber | 0756 C PCT Cont. US | 3604 |

7590 03/20/2003

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EXAMINER

BONCK, RODNEY H

| ART UNIT | PAPER NUMBER |
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3681

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,771

Applicant(s)

RABER, CHRISTOPH

Examiner

Rodney H. Bonck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-42, 45, 56-58, 60, 62, 63, 67-87, 90, 94-96, 98, 99, 104-106 and 108 is/are rejected.
- 7) ☒ Claim(s) 88, 89 and 97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 9,43,44,46-55,59,61,64-66,91-93,100-103,107,109 and 110.

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DETAILED ACTION

The following action is in response to the election received March 5, 2003, Paper No. 5.

Election/Restrictions

Applicant provisionally elects the invention of Group I and the Species of Fig. 1, listing claims 1-99, 104-106, 108, and 109 as readable on the elected invention and listing claims 1-8, 10-42, 45, 56-58, 60, 62, 63, 67-90, 94-99, 104-106, and 108 as readable on the elected species. The examiner agrees that claims 104-106 should have been grouped with the claims of Group I, rather than with the claims of Group II.

Claims 9, 43, 44, 46-55, 59, 61, 64-66, 91-93, 100-103, 107, 109, and 110 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 5.

Accordingly, the following is an action on the merits of claims 1-8, 10-42, 45, 56-58, 60, 62, 63, 67-90, 94-99, 104-106, and 108.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon applications filed in Germany on July 12, 1999, December 27, 1999, and March 27, 2000. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter. Note that if conditions are met for receiving benefit under 35 U.S.C. 120 for the parent PCT application, benefit under 35 U.S.C. 119 for the German applications would then appear to be proper.

Information Disclosure Statement

Receipt is acknowledged of the Information Disclosure Statement filed January 9, 2002. The cited documents have been considered, except note the change by the examiner under "Other Documents". Identifying the citation as "Prints of extensive correspondence..." is not seen as sufficient. It is assumed that the citation refers to the PCT search report showing the relevance of the cited documents.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the turbine or

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compressed air turbine of claim 72 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: "depeding", line 12 of page 31, apparently should be – depending –; and "bering", line 17 of page 32, apparently should be – bearing --.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 38 is objected to because of the following informalities: in line 4 of claim 38, "ech" apparently should be – each --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 72 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "such as" renders claim 72 indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-17, 20-25, 27-37, 40, 45, 67-70, 73-78, 83-87, 90, and 108 are rejected under 35 U.S.C. 102(b) as being anticipated by Helck('414). Helck discloses an apparatus for effecting relative movements of a first part 25 relative to a second part 21, one of which is turnable relative to the other. The apparatus has at least one tracking device 28 fixed relative to the first part and a helix 26 non-rotatably associated with the second part. Helix 26 includes a plurality of convolutions and the tracking device has a portion 29 extending between at least two of the convolutions. Means are provided for rotating one part relative to the other (see column 1, line 70, to column 3, line 25). Note that the end convolution of the helix is non-rotatably secured to the second part (Fig. 2). It is apparent from the figures in Helck that the thickness and width

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ratios of the convolutions and the width to outer diameter ratios would fall in the claimed ranges. The followers on the tracking device would divide the convolutions into a first package and a second package of neighboring convolutions. The provision of rollers on the followers is taught by the embodiments of Figs. 3 and 4 of Helck at 56. Note, too, that the first part 25 is surrounded by the second part 21 in Helck.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helck('414). Helck does not disclose the specific dimensions and materials called for in these claims. It is submitted, however, that choosing appropriate materials for a particular application and determining the appropriate size for the Helck device would have been within the purview of the artisan.

Claims 38, 39, 41, 42, 56-58, 60, 62, 63, 71, 72, 79-82, 94-96, and 104-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helck('414) in view of Staak('671). The followers in Helck are not "pin-shaped" as called for here. Staak shows a similar arrangement wherein axially spaced, pin-shaped followers with bearing

are used. It would have been obvious to use pin-shaped followers with bearings in the Helck device, the motivation being to facilitate movement of the followers along the helix. Note that Staak also suggests the provision of biasing means at 43,44. In Helck the means for rotating can be by hand, but Staak suggests using an electric motor. It would have been obvious to use an electric motor as the means for rotating in Helck, the motivation being to facilitate remote operation. Staak also teaches providing a sensor 47 for controlling operation of the motor, as part of the control means of Fig. 3.

Claims 98 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helck('414) in view of Stieg et al.('748). The Helck device is for axially adjusting the position of two members, but it is not disclosed as being for adjusting a variable diameter pulley. The Stieg et al. device shows first and second pulleys wherein at least one is a variable diameter pulley and wherein a means is provided for causing axial movement of a pulley part to effect a diameter change. Stieg et al. also show several prior art arrangements for providing this axial movement (Figs. 9-11). Since the Helck device is for providing axial adjustment and "is capable of a high degree of resolution of adjustment while sustaining a large loading force", it would be well adapted for use in the environment of Stieg et al. It would have been obvious to use the Helck device for adjusting a variable diameter pulley in an arrangement such as that of Stieg et al., the motivation being to take advantage of the adjustment features of the Helck device.

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Allowable Subject Matter

Claims 88, 89, and 97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hutchings('819) is cited to show helix 20 for causing axial movement of follower 18. Kuehnle('354), Bryant('638), Flint et al.('416), Avny('907), and Sugiyama et al.(JP 6-42603 A) show other helical cams and followers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:30AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-3597 for regular communications and (703)-305-3597 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Rodney H. Bonck
Primary Examiner
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rhb
March 17, 2003